REMARKS

Claims 1 to 30 remain pending. Claims 4, 5 and 14 to 30 have been withdrawn from consideration. Claim 31 has been added.

Claims 6 to 9 have been rejected under 35 U.S.C. 112, first paragraph, as being non-enabling for a perilla extract. The Action maintains that the Applicants have not enabled any perilla extract other than an aqueous extract in performing the desired function. The Action questions whether extracts other than the aqueous one will perform the desired function. The Action maintains that it is unpredictable as to whether an extract of a certain type will inherently possess an inherent medical quality.

The rejection of claims 6 to 9 is not well taken. The specification is enabling for extracts other than aqueous extracts because it teaches the use of perilla broadly, including extracts and oils. Page 6, lines 8 to 10, of the specification states "Examples of melanin uptake-inhibiting agents include extracts or oils derived from all or parts of the perilla plant,..." Page 6, lines 19 and 20, states "...extracts, concentrates or oils of other parts of the perilla plant..." Page 13, lines 5 to 7, states that "The cells were treated with different concentations [sic] of perilla leaf extract (powder form or aqueous form)." It is apparent from the foregoing that the specification is enabling for melanin uptake-inhibiting agents, including perilla extracts, much more broadly than just aqueous perilla extracts. The specification specifically discloses other materially different product forms (in addition to extracts),

such as concentrates and oils. In view of these materially different disclosed product forms, it is not a stretch to envision extracts extracted with solvents other than water. For instance, it is not a stretch to envision an extract extracted with an oil-soluble solvent when oils of perilla are clearly disclosed as being useful melanin uptake-inhibiting agents. Further, the specification clearly discloses perilla leaf extract in powder form.

Claims 1 to 3 have been rejected under 35 U.S.C. 102(b) as being anticipated by the International Product Alert (IPA). The Action states that the IPA discloses a beverage having coconut water diluted with natural water. The Action maintained that the amount of coconut water in the beverage of the IPA inherently provided the desired function.

The rejection of claims 1 to 3 under 35 U.S.C. 102(b) is traversed. Independent claim 1 requires that the composition be applied to the skin. The IPA is directed to beverages. Thus, claim 1 clearly distinguishes over the IPA.

Claims 1 to 3 and 10 to 13 have been rejected under 35 U.S.C. 103(a) as being anticipated by the IPA. The Action states that the nature of claims 1 to 3 and 13 was discussed in the 102(b) rejection above. The Action admits that the IPA does not disclose the amount of coconut water in the beverage. The Action maintained that it was obvious to vary the amount of coconut water in the beverage to manufacture drinks with fluctuating enhanced flavor.

The rejection of claims 1 to 3 and 10 to 13 under 35 U.S.C. 103(a) is traversed. Independent claim 1 requires that the composition be applied to the skin. The IPA is directed to beverages. Thus, claim 1 clearly distinguishes the IPA.

The Action states that Claims 6 to 9 were free of art and would be allowable if amended to overcome the rejection under 35 U.S.C. 112, first paragraph. Claim 6 has been amended to independent form suitable for allowance. The rejection under 35 U.S.C. 112, first paragraph, is overcome in view of the discussion above regarding that rejection. Claims 6 and 9 are deemed to be in condition for allowance.

Reconsideration of claims 1 to 3 and 6 to 13 is deemed warranted in view of the foregoing, and allowance of said claims as well as withdrawn claims 4 and 5 (non-elected species) and new claim 31 is earnestly solicited.

Respectfully submitted,

Dated: December 12, 2003

Charles N. J. Ruggiero
Reg. No. 28,468
Attorney for Applicants
Ohlandt, Greeley, Ruggiero
& Perle, L.L.P.
One Landmark Square
Stamford, CT 06901-2682
Tel: 203-327-4500